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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/239,024	01/27/99	BUCHWALD	S MTV-009.02

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EXAMINER

BARTS, S

ART UNIT

PAPER NUMBER

1621

DATE MAILED:

01/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/239,024

Applicant(s)
Buchwald et al

Examiner
SAMUEL BARTS

Group Art Unit
1621

☒ Responsive to communication(s) filed on Oct 30, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-70 is/are pending in the application.

Of the above, claim(s) 36-70 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1621

DETAILED ACTION

1. Applicant's election without traverse of Group I claims 1-35 and example 24 as the elected species in Paper No. 7 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-35 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hartwig et al(US 6,057,456).

The claimed invention is substantially disclosed in Hartwig et al. See for example Scheme I in column 3. Hartwig discloses the use of palladium ligands as the catalyst. For example, see column 4 lines 49-58. Hartwig disclosed the use of bases in column 5 lines 11-26. From the examples it is clear that Hartwig heats the reaction mixture. Hartwig discloses solvents in column 7 lines 14-31.


Application/Control Number: 09/239,024

Page 3

Art Unit: 1621

Minor differences may be claimed but are obvious depending on a skilled artisan's desired to make a particular compound and the degree of purification desired in making that compound.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Samuel Barts whose telephone number is (703)308-4630. The Examiner's normal tour of duty is between 6:30-3:00, M-F. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-1235. Communications may now be transmitted via FAX directly to group 1600. The official group 1200 FAX machine number is (703) 308-4556.


SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1600

S.B.
January 16, 2001
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